

REMARKS

The Official Action mailed August 20, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on March 15, 2004; February 9, 2005; August 30, 2005; and February 22, 2006.

A Correction to Previously Submitted Information Disclosure Statement dated March 15, 2004 is submitted herewith, which corrects the article entitled, "Background Separation/Filtering for Videophone Applications" to include "PROC. OF ICASSP (International Conference on Acoustics, Speech and Signal Processing)." Further, the publication date of KR 88000903 has been corrected by changing the date from March 30, 1998, to March 30, 1988. In the *Correction*, the Applicant requests that the attached PTO 1449 Form be initialed and that the previous erroneous citations be lined through.

Claims 1-20 were pending in the present application prior to the above amendment. Dependent claims 2, 5, 9, 12, 15 and 19 have been canceled without prejudice or disclaimer; independent claims 1, 4, 8, 11, 14 and 18 have been amended to better recite the features of the present invention; and new dependent claims 21-32 have been added to recite additional protection to which the Applicant is entitled. The Applicant notes with appreciation the indication of the allowability of dependent claims 7, 10, 17 and 20 (Box 7, Office Action Summary, page 8, Paper No. 20080807). Accordingly, claims 1, 3, 4, 6-8, 10, 11, 13, 14, 16-18 and 20-32 are now pending in the present application, of which claims 1, 4, 8, 11, 14 and 18 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1-22 under the doctrine of obviousness-type double patenting over claims 1-29 of U.S. Patent No. 6,707,484 to

Kawasaki. The Applicant respectfully submits that the amended independent claims of the subject application are patentably distinct from the claims of the Kawasaki '484 patent.

As stated in MPEP § 804, under the heading "Obviousness-Type," in order to form an obviousness-type double patenting rejection, a claim in the present application must define an invention that is merely an obvious variation of an invention claimed in the prior art patent, and the claimed subject matter must not be patentably distinct from the subject matter claimed in a commonly owned patent. Also, the specification and drawings of the patent principally underlying the double patenting rejection are not considered prior art.

The Applicant respectfully traverses the obviousness-type double patenting rejection. As is discussed in greater detail below, the independent claims have been amended to better recite the features of the present invention. In light of this amendment, the Applicant respectfully traverses this ground for rejection and reconsideration of the pending claims is respectfully requested. The claims of Kawasaki '484 do not teach or suggest the features of the amended independent claims.

It is respectfully submitted that the claims of the present application are not a timewise extension of the invention as claimed in the Kawasaki '484 patent. Reconsideration and withdrawal of the obviousness-type double patenting rejections are requested.

Paragraph 4 of the Official Action rejects claims 1-6, 8, 9, 11-16, 18 and 19 as obvious based on the combination of U.S. Patent No. 4,645,872 to Pressman, U.S. Patent No. 5,515,474 to Deacon and U.S. Patent No. 5,491,507 to Umezawa. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 1, 4, 8, 11, 14 and 18 have been amended to clarify that a personal computer or workstation comprises a display unit, a speaker and a microphone included in a first housing, and to newly recite that the personal computer or workstation comprises a keyboard and a pointing device included in a second housing. These features are supported in the present specification, for example, by Figure 3, and original claims 2, 5, 9, 12, 15 and 19. The Applicant respectfully submits that Pressman, Deacon and Umezawa, either alone or in combination, do not teach or suggest the above-referenced features of the present invention. Since Pressman, Deacon and Umezawa do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Furthermore, there is no proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Pressman, Deacon and Umezawa or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully

submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be modified in the manner asserted in the Official Action, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references "could have been" combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (emphasis in original). KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

The Official Action concedes that "Pressman does not teach that wherein the speaker is provided on at least one side of the display unit, ... and wherein the display unit, the speaker, and the microphone are included in a same housing" (page 4, Paper No. 20080807). The Official Action relies on Deacon to allegedly teach this feature. Without any specific references to Pressman or Deacon in support and without statements which establish the level of ordinary skill in the art at the time of the present invention, the Official Action asserts that "it would have been obvious ... to modify Pressman with Deacon to place the speaker in the desired arrangement that suit the user needs" (Id.). Also, the Official Action concedes that "Pressman in view of Deacon does not expressly teach that wherein the display unit, the speaker, and the microphone are included in a same housing" (page 5, Id.). The Official Action relies on Umezawa to allegedly teach this feature. Without any specific references to Pressman, Deacon or Umezawa in support and without statements which establish the level of ordinary skill in the art at the time of the present invention, the Official Action asserts that "it would have

been obvious ... to modify Pressman in view of Deacon with Umezawa teaching in order to have the desired design by the user" (Id.). The Applicant respectfully disagrees and traverses the above assertions in the Official Action.

The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit (KSR International Co. v. Teleflex Inc., 550 U.S. ___, 82 USPQ2d 1385). The Court quoting In re Kahn (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR, 550 U.S. at ___, 82 USPQ2d at 1396. In the present application, the Official Action appears to contain mere conclusory statements, for example, at pages 4-5, as noted above (Id.), and the Official Action has not set forth articulated reasoning with some rational underpinning to support the assertion of *prima facie* obviousness.

Specifically, for example, Figure 1 of Deacon appears to disclose a keyboard 12 and a mouse 13 as a pointing device. However, Deacon's keyboard 12 and mouse 13 are not included in a second housing. None of the cited references teaches or suggests why one of ordinary skill in the art at the time of the present invention would have necessarily integrated a display unit, a speaker and a microphone in a first housing of a personal computer or workstation, and a keyboard and a pointing device in a second housing of a personal computer or workstation.

As for the concept of integrating parts into a housing, it appears that the Official Action relies on Umezawa. However, Umezawa appears to teach "[a] handy type video telephone equipment," not a personal computer or a workstation. The Applicant respectfully submits that Umezawa is not in the field of the Applicant's endeavor, is not reasonably pertinent to the particular problem with which the inventor is concerned, and would not have logically commended itself to an inventor's attention in considering the problem. See, MPEP § 2141.01(a); In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d

1443, 1445 (Fed. Cir. 1992); In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); and In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Pressman, Deacon and Umezawa or to combine reference teachings to achieve the claimed invention.


In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 21-32 have been added to recite additional protection to which the Applicant is entitled. The features of claims 21-26 are supported in the present specification, for example, by page 12, lines 31-32; and the features of claims 27-32 are supported in the present specification, for example, by page 1, lines 4-8. For the reasons stated above and already of record, the Applicant respectfully submits that new claims 21-32 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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